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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,937	10/29/2003	Sylvia Monsheimer	237767US0	6145
22850	7590	09/01/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				ZACHARIA, RAMSEY E
		ART UNIT		PAPER NUMBER
		1773		

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/694,937	MONSHEIMER ET AL.	
	Examiner Ramsey Zacharia	Art Unit 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
 - 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 October 2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/29/2003.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: ____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The phrase "reinforcing layer I between and arranged off-center of the two elastomeric layers II" renders claim 14 indefinite because the configuration of the layers is unclear. For the purpose of examination, this limitation is taken to mean that the elastomeric layers have different thicknesses as shown in Figure 2 of the instant application.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-13 and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Baron et al. (DE 197 16 179 A1).

Because an English language translation was not available at the time of this action, the examiner has relied upon the Derwent abstract provided by the applicants and a preliminary oral translation of the patent.

Baron et al. teach a part comprising a reinforcing component and an elastomeric matrix. The reinforcing component (corresponding to fibrous reinforcing component I) may be in the form of strips or rods and comprises a polymer, such as polyamide or polyethylene terephthalate, having an elastic modulus of 1000-5000 N/mm². The reinforcing component has a thickness of 0.3-3 mm. The part may comprise up to 40 wt% reinforcing component. The elastomeric matrix may be vulcanized styrene-butadiene rubber, unvulcanized styrene-butadiene rubber, or ethylene-propylene diene rubber. An adhesive is optionally used to bond the reinforcing component and elastomeric matrix. The part may be made by laminating together a preformed rubber sheet and the reinforcing component. The part may be used to make a tire, which reads on an item of sports equipment (e.g. auto racing). In a tire, the part will experience bending in both a positive and negative direction of rotation (making the tire bends in one direction while bumps, potholes, etc. will force the part in the opposite direction), thus meeting the limitations of claim 20.

Regarding the ratio of rigidities recited in claims 1-4, the ratio appears to be a material property that is a function of the stiffness of the layers. Since the elastic modulus is a measure of stiffness and since both the part of Baron et al. and the instant bending element comprise layers

having overlapping elastic moduli, the part of Baron et al. should inherently have a ratio of rigidity that meets the limitations of instant claims 1-4.

Regarding claims 16 and 18, the limitations of these claims (i.e. the element is part of a sports shoe insert or prosthesis) are taken to be intended uses of the element. It has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baron et al. (DE 197 16 179 A1).

Baron et al. teach all the limitations of claims 14 and 15, as outlined above, except for the number and order of the reinforcing component and elastomeric matrix. However, Baron et al. do suggest varying the number and arrangement of the layers as may be desired. Therefore, it would have been obvious to one skilled in the art to adjust the number and dimensions of the reinforcing and elastomeric layers depending on the final application. For example, for applications requiring additional flexibility it would be obvious to use multiple elastomeric layers.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Zacharia whose telephone number is (571) 272-1518. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached at (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ramsey Zacharia
Primary Examiner
Tech Center 1700